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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,899	07/21/2003	Matthew J. Newsome	014801000510	7640
20350	7590	01/25/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			LE, UYEN CHAU N	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/623,899	NEWSOME ET AL.	
	Examiner	Art Unit	
	Uyen-Chau N. Le	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-19 is/are rejected.
- 7) ☒ Claim(s) 9 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prelim. Amdt/Amendment

1. Receipt is acknowledged of the Amendment filed 21 December 2005.

In view of the Applicant's argument with respect to "Kiribuchi fails to disclose an embodiment that writes to the fare card..." (page 2 of the remark) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Urquhart et al (US 6129275 A).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urquhart et al (US 6129275 A) in view of Hiroya et al (US 5,754,654).

Re claims 1 and 11: Urquhart et al discloses a stand alone terminal for conducting a plurality of cashless transactions for adding value to a plurality of smart cards, the terminal comprising: a display 20 for displaying information and instructions to a customer for adding value to a smart card of the plurality of smart cards; at least one smart card reader for reading from and writing to the fare card (figs. 1 & 9a-9b; col. 3, lines 40-50); a payment interface means comprising a debit/credit card reader 50 (i.e., via slot 16) for accepting at least one of a credit card and a debit card (figs. 1 & 9a-9b; col. 3, lines 40-50); and a control and memory assembly 20 comprising: means 52 for controlling the patron display 20;

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means for communicating with the at least one fare card reader for reading from and writing to the at least one fare card to complete at least one cashless transaction of the plurality of cashless transactions (fig. 9c); means 56 for communicating with the payment interface means to obtain debit/credit information (figs. 1 & 9a-9b; col. 4, line 65 through col. 5, line 13); means for issuing a new or recycled fare card (i.e., via dispensing slot 18) (figs. 1 & 9a-9b; col. 5, lines 63+).

Urquhart et al is silent with respect to utilize the system in a fare/ticket system including means for storing a history of the at least one cashless transaction.

Hiroya et al teaches an electronic ticket system comprises a storage for storing transaction history (figs. 1-4; col. 11, line 35 through col. 12, line 52).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to utilize the system of Urquhart et al in fare/ticket system as taught by Hiroya et al for intended use. Furthermore, such modification would provide Urquhart et al with having the ability of storing all transactions associated with the system for later user (e.g., verification purpose).

5. Claims 2-6, 10 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urquhart et al as

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modified by Hiroya et al as applied to claim 1 above, and further in view of Baker et al (US 4977502 A). The teachings of Urquhart et al as modified by Hiroya et al have been discussed above.

Re claims 2-6, 10 and 12-15: Urquhart et al/Hiroya et al has been discussed above and further discloses a fare/ticket card 30 is a contact/contactless smart/IC card and terminal 3 having a contact/contactless smart/IC card reader/writer 26 (figs. 1-4; col. 11, line 35 through col. 12, line 52), but is silent with respect to a magnetic stripe card reader for reading from and writing to a magnetic stripe card of the plurality of fare cards, and a plurality of selection buttons adjacent the patron display for selecting options in response to the displayed information and instructions, respectively.

Baker et al teaches a magnetic fare card processor 154 comprises a card reader 27 and processor structure that reads, writes, and verifies magnetic data carried in a strip of magnetically-orientable material on a magnetic fare card (fig. 8; col. 11, line 35 through col. 13, line 2) and a plurality of selection buttons 36 adjacent the patron display for selecting options in response to the displayed information and instructions (fig. 1).

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It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Baker et al into the system as taught by Urquhart et al/Hiroya et al in order to enhance the system flexibility wherein the user can choose to use either a magnetic card, a contact or contactless fare card when using public transportation system. Furthermore, such modification would simplify the use of the ticket/card terminal by providing selection buttons adjacent the display for selecting options in response to the displayed information and instructions, thus encourage more user to use the terminal.

6. Claims 7, 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urquhart et al as modified by Hiroya et al as applied to claim 1 above, and further in view of Adams (US 5,255,182). The teachings of Urquhart et al as modified by Hiroya et al have been discussed above.

Re claims 7, 8 and 16: Urquhart et al/Hiroya et al has been discussed above but is silent with respect to the history of the at least one cashless transaction is uploaded from the control and memory assembly to the transit station area controller at a pre-determined time, wherein the pre-determined time for uploading the history is after each cashless transaction of the plurality of cashless transactions.

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Adams teaches terminal 1 can be programmed to upload transaction data spontaneously after a preset time interval or after a preset number of transactions (i.e., a preset number of transactions can be 1 or after each transaction) (col. 11, lines 6-21).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate teachings of Adams into the system as taught by Urquhart et al/Hiroya et al in order to provide Urquhart et al/Hiroya et al with more feasible system in which information data of each transaction can be upload and stored at the server, thus a large capacity memory is not required at each terminal for storing transaction data. Furthermore, such modification would provide the user flexibility in retrieving transaction data from the server/host at any station/terminal via the network system, and therefore an obvious expedient.

7. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urquhart et al as modified by Hiroya et al as applied to claim 1 above, and further in view in view of Raspotnik (US 5,832,090). The teachings of Urquhart et al as modified by Hiroya et al have been discussed above.

Re claims 17-19: Urquhart et al/Hiroya et al has been discussed above but is silent with respect to communicating with

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the transit station controller for authorizing a transaction value of the plurality of transaction values; and writing the authorized value to the fare card utilizing the one of a magnetic stripe card reader and the contactless card reader.

Raspotnik teaches a fare collection system comprises a reader/writer 14 communicating with the central host computer 15, which controls the mass transit system, for authorizing a transaction value (i.e., increase the data value stored in the fare card/transponder 11) (col. 4, lines 12-43 and col. 5, lines 6-35).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Raspotnik into the system as taught by Urquhart et al/Hiroya et al in order to provide Urquhart et al/Hiroya et al with a time consumption system wherein the transaction authorization process is determined directly by the transit system controller, which eliminates a long waiting time of authorizing process from credit companies.

Allowable Subject Matter

8. Claims 9 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

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independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of records and all other cited references, taken alone or in combination, fails to teach or fairly suggest the specific structure and method for conducting a plurality of transaction values to a plurality of fare cards comprising, among other things, the fare card is a special status fare card, wherein the transit controller has pre-authorization to utilize stored debit/credit information for authorizing the transaction value; the controller adds value to the special status fare card without obtaining the credit/debit information through the debit/credit card reader as set forth in the claimed combination.

Raspotnik teaches the mass transit central host computer 15 communicating with a reader/writer 14 for authorizing a transaction value (i.e., increase the data value stored in the fare card/transponder 11) (col. 4, lines 12-43 and col. 5, lines 6-35), but is silent with respect to a special status fare card, wherein the transit controller has pre-authorization to utilize stored debit/credit information for authorizing the transaction value.

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Response to Arguments

10. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Newly cited references to Urquhart et al have used in the new grounds of rejection to further meet the claimed limitation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on First Monday 5:30AM-1:30PM and Tues-Fri 5:30AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Uyen-Chau N. Le
Primary Examiner
Art Unit 2876

January 19, 2006